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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,788	09/26/2005	Tomoyuki Okada	92478-0900	8335

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EXAMINER	
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ART UNIT	PAPER NUMBER
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,788	OKADA ET AL.	
	Examiner	Art Unit	
	DAQUAN ZHAO	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/10/2008; 12/4/2008; 7/16/2008; 11/6/2007; 9/28/2007; 6/13/2005; 2/28/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 69-71 are rejected under 35 U.S.C. 101 because of the following reasons:

For claim 69, the claim is directed to "a playback processing program" per se. A program per se is a non-statutory subject matter.

For claims 70-71, the claim is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Although claim70 is directed to the playback method relating to a recording medium, there's nothing in the claim to specify how the method playback the recording medium using any apparatus or device. Instead, the body of the claim only directs to the data structure of the recording medium. Claim 71 also fails to

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

specify any recording apparatus or device for recording the application data in the recording medium or How the application data is recorded on the recording medium using any apparatus or device.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 48-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Cho et al (US 2002/0,176,693 A1), and in reference of Saeki et al (US 6,067,400).

For claim 48, Cho et al teach a recording medium having video data, a plurality of programs, and a table recorded thereon (e.g. abstract, paragraph 32 and paragraph 35 teach the program Chain Information Table, the Program Chain, or PGC, corresponds to the claimed "a plurality of programs", the PGC is also called VOB), wherein each of the plurality of programs shows a playback control procedure of the video data (e.g. It is inherent that the PGC shows a playback control procedure, Saeki et al teach in column 16, lines 36-55, the inherent feature of a PGC is to specify the reproduction route. Saeki et al is introduced for inherent feature of the conventional DVD only), the table includes (1) identification information of each of the plurality of programs (e.g. paragraphs 36-40, PGCI#1, PGCI#2 identifies the number of PGC) , and (2) information showing that each

of the plurality of programs belongs to one of a movie-mode and an enhanced-mode (e.g. paragraphs 57-58 and figure 11, the “script Flag” identifies the script display mode as shown in step S37 and the general DVD reproducing operation mode as shown in step S33), one of the plurality of programs includes a command for branching, and the branching command specifies a branch destination using indirect referencing via the table (e.g. Saeki et al shows the Branding command is a inherent feature of the convention DVD operation see column 15, lines 57-61 of Saeki et al, the Branching command has to be there in the convention DVD for the PGC reproduction route).

Claims 59, 69-71 are rejected for the same reasons as discussed in claim 48 above.

For claims 49 and 60, Cho et al teach in the table, a title number is assigned to each pair of (1) the identification information and (2) the information, and the indirect referencing is to specify a program of the branch destination, using the title numbers (e.g. figure 3, title search pointer Table).

For claims 50 and 61, Cho et al teach the enhanced-mode is a mode for causing a virtual machine to execute a program, and an enhanced-mode program is described in a virtual machine-oriented programming language (e.g. the script file is execute in steps S37-S41 and figure 13, figure 12 shows the displayed script file, the examiner considers the display program of Cho et al to perform steps S37-S41 as the claimed "Virtual machine-oriented program language").

For claims 51 and 62, Cho et al teach a movie-mode program and an enhanced-mode program each are executed by two or more execution modules, the two or more

execution modules are resident programs on a same layer in a control hierarchy, and the playback control procedure is a process description of a process for the same layer, described using one of (1) a command interpretable by the two or more execution modules and (2) a class structure function supplied from the two or more execution modules (e.g. Steps S33 and S37 of figure 13 corresponds to the claimed modules and figure 13 is considered to be the claimed control Hierarchy. Steps s33 and S37 are in the same layer because they are two different steps of the reproduction procedure).

For claim 52, Cho et al teach the class structure function is one of (1) a function fox causing a playback device to execute a playback control based on a predefined playback path, (2) a function for setting a predetermined value to a register in the playback device and (3) a function for acquiring the value set to the register (e.g. this is the inherent feature of the conventional DVD, see Saeki et al column 15, lines 57-65 for setting up register for the branching operation).

For claims 53 and 63, Cho et al teach the value set to the register is a value showing one of (1) an audio setting in the playback device, (2) a subtitle setting in the playback device, (3) an angle setting in the playback device, (4) a currently played title, (5) a currently played chapter, and (6) a current playback point (e.g. figure 5 of Cho et al shows PGC user operation control and PGC Audio stream control Table and setting the register value to one of the (1) to (6) belongs to the button command as taught in Saeki et al column 15, line 46- column 16, line18).

For claims 54 and 64, Cho et al teach having pieces of playlist information recorded thereon, wherein each piece of the playlist information defines a playback path

by arranging pieces of information showing playback sections in the video data according to a playback order, and the playback control executed with the class structure function is based on the playback path defined by each piece of the playlist information (this claimed feature is also inherent to the conventional DVD, see column 16, lines 35-55 of Saeki et al, the PGC is considered to be the playlist because it defined the reproduction route from one VOB to another VOB, wherein each VOB has start and end).

For claims 55 and 65, Cho et al teach each of the plurality of programs includes a function call for calling the class structure function for executing the playback control, the function call includes two arguments, of the two arguments, a first argument specifies a piece of the playlist information, and a second argument specifies a starting point in the playback path (this claimed feature is also inherent to the conventional DVD, see column 16, lines 35-55 of Saeki et al, the PGC is considered to be the playlist because it defined the reproduction route from one VOB to another VOB, wherein each VOB has start and end).

For claims 56 and 66, Cho et al teach the starting point is specified using one of a playback section, a playback time, and a chapter (this claimed feature is also inherent to the conventional DVD, see column 16, lines 35-55 of Saeki et al, the PGC is considered to be the playlist because it defined the reproduction route from one VOB to another VOB, wherein each VOB has start and end, The VOB corresponds to a “chapter”).

For claims 57 and 67, Cho et al teach the branching is to branch from the movie-mode program to the enhanced-mode program, the playback control procedure performed by the movie-mode program is to specify a starting point in the playback path defined by a piece of the playback information for playback execution, and the playback control procedure performed by the enhanced-mode program is to specify the starting point in the playback path defined by the same piece of the playback information for playback execution (e.g. paragraph 57-58, the script file is identified by address).

For claim 58, Cho et al teach a movie-mode program includes a button command, the button command is a command for branching to the enhanced-mode program, and is recorded on the recording medium as a multiplexed stream after being multiplexed with the video data and subtitle data, and each piece of the subtitle data is image data of a button, and the button command is executed when a confirmation operation is conducted with respect to the image data of the button (e.g. This is also an inherent feature of the conventional DVD; button command as taught in Saeki et al column 15, line 46- column 16, line18).

For claim 68, Cho et al teach a demultiplexer operable to demultiplex a multiplex stream to obtain a button command, the video data, subtitle data (e.g. paragraphs 53-54the DSP 12 A obtain the user input from the RF signal, which the examiner considered to be the button command from the remote control of the DVD player); an image decoder operable to decode image data of a button (e.g. decoder 12b); and a video decoder operable to decode the video data (e.g. decoder 12b), wherein a movie-mode program includes the button command, the button command is a command for

branching to the enhanced-mode program, and is recorded on the recording medium as the multiplex stream after being multiplexed with the video data and the subtitle data, each piece of the subtitle data is the image data, and the movie-mode corresponding module executes the button command when a confirmation operation is conducted with respect to the image data (e.g. the user input button command, video data, and subtitle data has to output from device 12, and device 12 has only one output. therefore, all the video and subtitle data has to be multiplexed in device 12 of figure 10).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ando et al (US 6215746); Tsumagari et al (US 2003/0,161,615).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daquan Zhao

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621